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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,052	05/06/2004	Harry C. Morris	DMBC-0007	6640

7590 12/12/2005

Jane Massey Licata  
Licata & Tyrrell P.C.  
66 E. Main Street  
Marlton, NJ 08053

EXAMINER
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ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/840,052	<b>Applicant(s)</b> MORRIS, HARRY C.	
	<b>Examiner</b> John J. Zimmerman	<b>Art Unit</b> 1775	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/27/05 (RCE papers).  
 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-10 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 3-10 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 06 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **THIRD OFFICE ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 27, 2005 has been entered.

### ***Amendments***

2. The amendments to the claims submitted with the Reply under 37 C.F.R. 1.116 received September 26, 2005 have been entered as instructed on the RCE transmittal form received October 27, 2005. Claims 3-10 are pending in this application.

### ***Priority***

3. The subject matter of the pending claims only have priority as the filing date of this pending application (May 6, 2004). When a pending claim contains *any* limitation (e.g. Rockwell C hardness of "greater than 70") which cannot be found in a parent application, then the priority for that claim ends with the last continuous uninterrupted line of support.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lindblad (U.S. Patent 4,970,560) in view of Mahoney (U.S. Patent 3,810,558).
6. Lindblad discloses plating a carbon steel blade with nickel-phosphorus of a thickness of about 5 microns and then heat treating to increase hardness of the coating to a hardness of 68-70 Rc (e.g. column 4, lines 33-49). The use of beveled blades (e.g. column 2, line 53) and square blades (e.g. see Figure 2) are shown by Lindblad to be obvious alternative in the art depending on the particular use of the blade. Lindblad may differ from the claims in that Lindblad may not require a Rockwell C hardness of "greater than 70" (e.g. claim 10, lines 8-9; claim 8, line 8), but the difference between Lindblad's hardness of 70 Rc and applicant's claimed "greater than 70" Rc is so minor that *prima facie* one of ordinary skill in the art would expect the coated blades to essentially be the same. There is no patentable distinction between the blades of Lindblad and the blades claimed by applicant. Regarding claim 3's recitation of "electroless" nickel, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q.

Art Unit: 1775

324. Regarding the recitation in the claims that the blade is a coater blade or doctor blade for applying inks and coating to paper and packaging, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The blade of Lindblad is certainly capable of applying inks and coatings to paper. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation of intended use for the blade has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Lindblad may differ from the claims in that Lindblad may not disclose that his blade is packaged in a coiled roll. Mahoney, however, discloses that it has long been recognized that economy and convenience result if long coiled lengths of blades are packaged so that shorter lengths could be dispensed as needed and that advantages such as less handling, less inventory, less storage space and lower transportation costs results from packaging blades in this manner (e.g. column 1, lines 6-31). In view of Mahoney, it would have been obvious to one of ordinary skill in the art at the time the invention was made to package the blades of Lindblad in coiled rolls because Mahoney discloses that packaging in coiled rolls results in economy, convenience, less handling, less inventory, less storage space and lower transportation costs.

7. Claims 3 and 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lindblad (U.S. Patent 4,970,560) in view of Mahoney (U.S. Patent 3,810,558) as applied to claims 3-8 and 10 above, and further in view of Calnan (U.S. Patent 3,490,314).

8. Lindblad may differ from claims 3 and 9 in that Lindblad's nickel-phosphorus coating may be electrodeposited (e.g. see column 4, lines 33-36). Calnan, however, clearly discloses that hard nickel-phosphorus coatings on blades can be deposited either electrolytically or electrolessly (e.g. column 2, lines 19-28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use either electroplating or electroless plating to apply the nickel-phosphorus coatings to the blades of Lindblad because Calnan shows that either process can be used.

9. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calnan (U.S. Patent 3,490,314) in view of Mahoney (U.S. Patent 3,810,558).

10. Calnan discloses plating a low carbon steel blade or stainless steel blade (e.g. column 2, lines 5-11) with nickel-phosphorus of a thickness of up to 0.005 inch (e.g. see column 2, lines 65-69) and then heat treating to increase hardness of the coating (e.g. column 3, lines 4-15). The use of beveled blades is disclosed (e.g. honing - column 3, lines 16-19), but the examiner notes that square edge blades are also typically used in the art. Calnan may differ from the claims in that Calnan may not disclose the Rockwell C hardness of the nickel-phosphorus layer after heat

Art Unit: 1775

treating, but Calnan does disclose that heat treating can be done to maximum hardness (e.g. column 3, lines 4-15). In view of the fact that Calnan heat treats his nickel-phosphorus coatings to maximum hardness, and applicant uses the same coating composition, it must be assumed that the hardness results would be the same as applicant's results. Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. 102 or on prima facie obviousness under 35 U.S.C. 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). Regarding the recitation in the claims that the blade is a coater blade or doctor blade for applying inks and coating to paper and packaging, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The blades of Calnan are certainly capable of applying inks and coatings to paper. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation of intended use for the blade has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or

Art Unit: 1775

structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Calnan may differ from the claims in that Calnan may not disclose that his blade is packaged in a coiled roll but Calnan does clearly show that his blade stock is coated and sharpened while in the form of continuous strips (e.g. see column 2, lines 65-69) before the manufacturing step of being divided into individual blades. Mahoney is cited to show that it is well understood in the manufacturing art that continuous strip stock is typically handled and transported in coiled form for ease of transport and handling (e.g. column 1, lines 6-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to coil the continuous strip blade stock of Calnan between some or all of the coating, sharpening and dividing manufacturing steps because Mahoney clearly shows that it is understood by one of ordinary skill in the manufacturing art that continuous strips of blade stock are most easily transported and handled when in coiled form.

### ***Response to Arguments***

11. Applicant's arguments filed September 26, 2005 have been fully considered but they are not persuasive. Applicant has amended the pending claims to further recite packaging the blades in coiled rolls. Mahoney (U.S. Patent 3,810,558), however, has been applied to clearly show that it has long been recognized that economy and convenience result if long coiled lengths of blades are packaged so that shorter lengths could be dispensed as needed and that advantages such as less handling, less inventory, less storage space and lower transportation costs results from packaging blades in this manner (e.g. column 1, lines 6-31). Lemetyinen (U.S. Patent



Art Unit: 1775

Application Publication 2004/0260616) and Liiri (U.S. Patent Application Publication 2004/0054608) are also further cited (see enclosed form PTO-892) to confirm that blades in the art are conventionally packaged and shipped in coiled form.

12. Regarding the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over Lindblad (U.S. Patent 4,970,560), applicant has previously argued that Lindblad is not a coater blade or doctor blade for applying inks and coating to paper and packaging. The examiner notes, however, that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The blade of Lindblad is certainly capable of applying inks and coatings to paper. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation of intended use for the blade has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

13. Regarding the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over Calnan (U.S. Patent 3,490,314), applicant has previously argued that Calnan's blade is not a

Art Unit: 1775

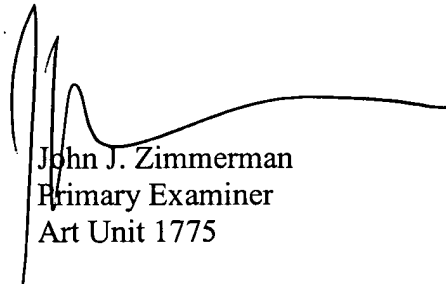
coater blade or doctor blade for applying inks and coating to paper and packaging. The examiner notes, however, that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The blades of Calnan are certainly capable of applying inks and coatings to paper. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation of intended use for the blade has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1775

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
December 2, 2005